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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/506,969	09/08/2004	Jeroen Karel Verbrugge	13877/13501	6946
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KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004			EXAMINER HICKS, ROBERT J	
			ART UNIT 3781	PAPER NUMBER
			MAIL DATE 11/05/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/506,969

Applicant(s)

VERBRUGGE ET AL.

Examiner

Robert J. Hicks

Art Unit

3781

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The amendment filed on October 18, 2007 under 37 CFR 1.111 has been entered. The examiner acknowledges the amendments to the abstract, specification, and the claims.
2. Because of applicant's amendments, the original objections and rejections to the following have been withdrawn:
 - a. Objections to the drawings.
 - b. Claim objection to claim 3.
 - c. Claim rejection under 35 U.S.C. § 112 1st Paragraph to claim 10.

Abstract

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

4. The amended abstract of the disclosure is objected to because the phraseology "said" (Amended Abstract Line 3) is used. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-24 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Regarding amended claims 1 and 24, the phrase "or the like" (Claim 1 Line 2, Claim 24 Line 3) renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

8. Claims 2-23 are objected to as being dependent upon rejected amended base claim 1.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 1-2, 4-12, 14-22, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stern et al. (U.S. Patent No. 6,102,235) [hereinafter Stern] in view of Luburic (Canadian Patent Application No. 2,379,436).

12. Regarding Claim 1, the patent to Stern – a lid with integral roller tray – discloses the following:

Packaging for a substance which is applied to a base using a roller (19) or the like, which packaging comprises:

a container (13) for the substance having an open top side (around 9), and
a lid (1) connected to the top side of the container by coupling means (7, Col. 5 Lines 10-12), which lid comprises: a first covering part (21) and a second covering part (3); the first covering part being provided on the underside with a region with a substance-distributing profile (31), and it being possible for the first covering part to be pivoted open about a hinge (87), which is located between the first covering part and the second covering part (Fig. 10), in such a manner that, to use the substance-distributing profile, the first covering part can be positioned at an angle (Fig. 4) with respect to the second covering part, which remains connected to the container (Fig. 1), and the hinge between the first covering part and the second covering part being integrally moulded as part of the lid (Fig. 10).

Stern does not expressly disclose that the lid is formed integrally from plastic by injection moulding, or that the hinge is leak tight with respect to the substance; however, the publication to Luburic – a container with lid – discloses that the lid and container are

"...fabricated by injection molding ... preferably to provide a suitably strong, lightweight, liquid-tight assembly" (Luburic, Page 5 Lines 19-21). It would have been obvious at the time of the invention to one of ordinary skill, using the teaching, suggestion, and motivation within the prior art, to manufacture the lid on the Stern paint roller tray out using an injection molding process, and to make the hinge leak tight, as suggested by Luburic, so that the container substance does not leak out, and that the lid is made into a one-piece model.

Although Luburic is a regular container with lid, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the Stern lid is not made of plastic; however, the Luburic lid teaches the lid can be made of plastic by injection molding, to help drive down the cost of manufacturing the lid out of metal, as indicated by market forces.

13. Regarding Claim 24, Stern teaches a lid (1) which is intended to be connected (7, Col. 5 Lines 10-12) to the open side (around 9) of a container (13) for a substance that is applicable by a roller (19), said lid comprising: a first covering part (21) and a second covering part (3); the first covering part being provided on the underside with a region with a substance-distributing profile (31), and it being possible for the first covering part to be pivoted open about a hinge (87), which is located between the first covering part and the second covering part (Fig. 10), in such a manner that, to use the substance-

distributing profile, the first covering part can be positioned at an angle (Fig. 4) with respect to the second covering part, which remains connected to the container (Fig. 1), and the hinge between the first covering part and the second covering part being integrally moulded as part of the lid (Fig. 10).

Stern does not expressly disclose that the lid is formed integrally from plastic by injection moulding, or that the hinge is leak tight with respect to the substance; however, the publication to Luburic – a container with lid – discloses that the lid and container are “...fabricated by injection molding ... preferably to provide a suitably strong, lightweight, liquid-tight assembly” (**Luburic**, Page 5 Lines 19-21), as stated in Paragraph 12 of this office action.

14. Regarding Claim 2, Stern in view of Luburic discloses all the limitations substantially as claimed, as applied to claim 1 above; further, Stern teaches that the hinge extends transversely over the entire lid (**Stern**, Fig. 7).

15. Regarding Claim 4, Stern in view of Luburic discloses all the limitations substantially as claimed, as applied to claim 1 above; further, Stern teaches the first covering part (**Stern**, 21) has a protective rim (**Stern**, 25) which protective rim is located on the underside of the first covering part and extends around the region with the substance-distributing profile, with the exception of the side on which the hinge (**Stern**, 87) is located (**Stern**, Fig. 1).

16. Regarding Claim 5, Stern in view of Luburic discloses all the limitations substantially as claimed, as applied to claim 4 above; further, Stern teaches the protective rim (**Stern**, 25) is substantially U-shaped in cross section, preferably

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substantially at right angles with respect to the plane of the lid, with the open side facing towards the first covering part, while the first covering part is interrupted over the width of the protective rim (**Stern**, Fig. 1).

17. Regarding Claims 6-7, Stern in view of Luburic discloses all the limitations substantially as claimed, as applied to claims 1 and 4 above, respectfully; further, Stern teaches the protective rim (**Stern**, 25) is designed and arranged in such a manner that this protective rim interacts with parts of the side walls of the container which bear against the outside of the protective rim, in order to form a seal (**Stern**, Col 5 Lines 44-46). The design of the bottom of the protective rim protrudes down into the opening of the lid, and can form a seal with the container.

18. Regarding Claim 8, Stern in view of Luburic discloses all the limitations substantially as claimed, as applied to claim 1 above; further, Stern teaches in the lid there are ribs (**Stern**, 35) for increasing stiffness of the packaging or parts of the packaging.

19. Regarding Claim 9, Stern in view of Luburic discloses all the limitations substantially as claimed, as applied to claim 1 above; further, Luburic teaches the coupling means for the second covering part (**Luburic**, 32) is designed as a integral locking rim (**Luburic**, 33), which during use of the packaging, retains the connection between the second covering part and the container. If the tear strip is not used on the package, the tear strip can be described as a locking rim.

20. Regarding Claim 10, Stern in view of Luburic discloses all the limitations substantially as claimed, as applied to claim 1 above; further, Stern teaches the

coupling means for the first covering part (**Stern**, 103) is designed for easily releasable coupling and is provided with a seal, which can be broken prior to first use. The examiner interprets the connection of the coupling means (**Stern**, 103) and the tabs (**Stern**, 111) as a seal that can be easily broken.

21. Regarding Claim 11, Stern in view of Luburic discloses all the limitations substantially as claimed, as applied to claim 9 above; further, Stern teaches the coupling means (**Stern**, 7) are designed to form a click-fit connection to the container (**Stern**, Fig. 13b, Col. 7 Lines 62-65). When the outer wall (**Stern**, 125) is flexed outward to allow the bead (**Stern**, 117) to enter, upon entry the outside wall will fold inward or snap back into place, thus forming the seal.

22. Regarding Claim 12, Stern in view of Luburic discloses all the limitations substantially as claimed, as applied to claim 1 above; further, Stern teaches that the container (**Stern**, 13, Fig. 15) and the lid (**Stern**, 1, Fig. 1) are substantially rectangular in shape.

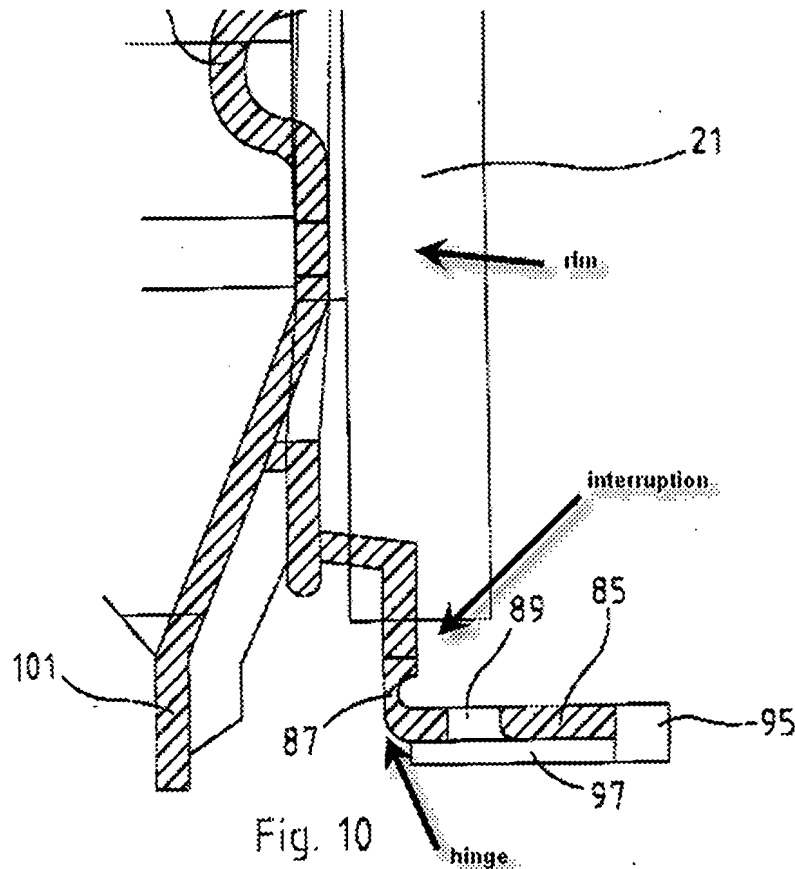
23. Regarding Claim 14, Stern in view of Luburic discloses all the limitations substantially as claimed, as applied to claim 1 above; further, Luburic teaches the dimension of the first covering part (**Luburic**, 34) in the plane of the lid (**Luburic**, 30), perpendicular to the hinge, is approximately three times as great as the dimension of the second covering part (**Luburic**, 32) in the plane of the lid (**Luburic**, Fig. 1). Stern in view of Luburic discloses the claimed invention except for the length of the first covering part being approximately three times the length of the second covering part. It would have been an obvious matter of design choice to modify the length of the first covering

part to three times the length of the second covering part, since applicant has not disclosed that the dimension of the covering parts solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the first covering part being three times the length of the second covering part.

24. Regarding Claim 15, Stern in view of Luburic discloses all the limitations substantially as claimed, as applied to claim 1 above; further, Stern teaches the opening in the container (**Stern**, around 9) which is opened up after the first covering part (**Stern**, 21) has been pivoted open is sufficiently large for a standard roller (**Stern**, 19) for applying a substance to a base to be able to fit through it easily.

25. Regarding Claim 16, Stern in view of Luburic discloses all the limitations substantially as claimed, as applied to claim 1 above; further, Stern teaches the lid (**Stern**, 1) has a projecting rim (**Stern**, 23) on the top side.

26. Regarding Claim 17, Stern in view of Luburic discloses all the limitations substantially as claimed, as applied to claim 16 above; further, Stern teaches the projecting rim (**Stern**, 23) extends along the entire periphery of the lid, and is interrupted at the location of the hinge (**Stern**, 87, Fig. 10).



27. Regarding Claim 18, Stern in view of Luburic discloses all the limitations substantially as claimed, as applied to claim 16 above; further, Stern teaches the base of the container (**Stern**, 13) has a space for receiving the projecting rim (**Stern**, Fig. 15).

28. Regarding Claim 19, Stern in view of Luburic discloses all the limitations substantially as claimed, as applied to claim 16 above; further, Stern teaches the projecting rim (**Stern**, 23) is designed as a locating rim, which acts in combination with the space in the base of the container (**Stern**, 13).

29. Regarding Claim 20, Stern in view of Luburic discloses all the limitations substantially as claimed, as applied to claim 1 above; further, Stern teaches the supporting of the first covering part at an angle (**Stern**, Fig. 4) with respect to the

second covering part is realized by supporting elements (**Stern**, 55 and 59) which are integrated with the first covering part and the second covering part, respectively.

30. Regarding Claim 21, Stern in view of Luburic discloses all the limitations substantially as claimed, as applied to claim 20 above; further, Luburic teaches the projecting rim (**Luburic**, 33) on the second covering part (**Luburic**, 32) forms a supporting element.

31. Regarding Claim 22, Stern in view of Luburic discloses all the limitations substantially as claimed, as applied to claim 20 above; further, Stern teaches the lid (**Stern**, 1) comprises at least one connecting member (**Stern**, 47) which is responsible for fixing the first covering part at an angle (**Stern**, Fig. 4) with respect to the second covering part.

32. Claims 3 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stern in view of Luburic as applied to claims 1 and 2 above, respectfully, and further in view of Rich (U.S. Patent No. 3,412,890).

33. Regarding Claim 3, Stern in view of Luburic discloses all the limitations substantially as claimed, as applied to claim 2 above. Although Stern teaches the top side (**Stern**, 9) of the container (**Stern**, 13) has an outer edge (**Stern**, 117) and adjoins the lid (**Stern**, 1) in a manner to form a seal (**Stern**, Col. 5 Lines 10-12), the Stern and Luburic combination does not expressly disclose projections at the location where the hinge ends at the end of the container. However, the patent to Rich – a hinged container closure – teaches a hinge (**Rich**, 29) with projections (**Rich**, 34, 35) at the ends of the container lid (**Rich**, Fig. 6, Col. 2 Lines 60-63). It would have been obvious

at the time of the invention to one of ordinary skill, using the teaching, suggestion, and motivation within the prior art, to add the webs at the hinge ends of the Stern and Luburic combination lid, as suggested by Rich, to add structural strength to the lid.

34. Regarding Claim 13, Stern in view of Luburic discloses all the limitations substantially as claimed, as applied to claim 1 above. The Stern and Luburic combination does not expressly disclose a breakable connection between the covering parts at the end of the hinges; however, the patent to Rich teaches projections (**Rich**, 34, 35) at both ends of a hinge (**Rich**, 29, Fig. 6, Col. 2 Lines 68-70). It would have been obvious at the time of the invention to one of ordinary skill, using the teaching, suggestion, and motivation within the prior art, to add the breakable webs at the hinge ends of the Stern and Luburic combination lid, as suggested by Rich, so that the user will know when the container has been used, by noticing the broken webs.

35. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stern in view of Luburic as applied to claim 1 above, and further in view of Lallement et al. (U.S. Pre-Grant Publication No. 2001/0013518) [hereinafter Lallement].

Stern in view of Luburic discloses all the limitations substantially as claimed, as applied to claim 1 above. Although the Stern and Luburic combination teaches the substance-distributing profile is formed by ribs (**Stern**, 35), which project downwards out of the plane of the lid and that recesses are formed in the lid, the combination does not expressly teach the recesses formed on the top side of the lid. However, the publication to Lallement – a paint tray with roller means – teaches a tray (**Lallement**, 100) with a

first half (**Lallement**, 11) "...[with] rounded indentations projecting alternately upwards and downwards ..." (**Lallement**, Fig. 3, Paragraph 41 Lines 4-5). It would have been obvious at the time of the invention to one of ordinary skill, using the teaching, suggestion, and motivation within the prior art, to modify the top of the lid on the Stern and Luburic combination with the alternating rounded indentations, as suggested by **Lallement**, for assistance in "spreading paint effectively in uniform manner over the roller" (**Lallement**, Paragraph 41 Lines 2-3).

Response to Arguments

36. Applicant's arguments filed October 18, 2007 have been fully considered but they are not persuasive.

37. In response to applicant's argument that there is no suggestion to combine the references (**Remarks**, Page 13 Lines 6-11), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation is that the cost of making a lid out of injection molding is cheaper based on market driven forces to drive down the cost of making parts.

38. In response to applicant's argument that Stern is not concerned or gives specific details about the interface between the lid and the container (**Remarks**, Page 13 Lines

18-20), Stern clearly teaches the interface between the lid and the container top to form a seal (**Stern**, Col. 5 Lines 10-12).

39. In response to applicant's argument that Luburic fails to provide further details about the structure of the two parts (**Remarks**, Page 13 Lines 26-28), the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case, the reason for combining Luburic with Stern is because Luburic teaches that the lid can be injection molded, and can provide a leak tight seal at the hinge.

40. In response to applicant's argument that a hinge cannot be fabricated by injection molding (**Remarks**, Page 14 Lines 1-2), Stern teaches that the hinge is integrally molded with the lid (**Stern**, 87, Fig. 10). Luburic teaches injection molding, and that can be added with Stern's current mentioning of an integrally molded part allows one of ordinary skill in the art to manufacture the hinge with the lid in an injection molding operation.

41. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "the hinge line supporting the weight of the second portion [**Remarks**, Page 14 Lines 9-12]) are not recited in the rejected claim(s). Although the claims are interpreted

in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Because of the above-mentioned reasoning, the examiner maintains the rejections under 35 U.S.C. 103(a) as stated above.

Conclusion

42. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert J. Hicks whose telephone number is (571) 270-1893. The examiner can normally be reached on Monday-Friday, 7:30 AM - 4:00 PM, EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Stashick can be reached on (571) 272-4561. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Robert Hicks/RH
10/30/2007



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